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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,806	08/25/2006	Paul Crocker	DAVIDK 3.3-017	2181
530 7590 04/10/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER				
CHAN, SING P				
ART UNIT		PAPER NUMBER		
1791				
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04/10/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,806

Applicant(s)

CROCKER ET AL.

Examiner

SING P. CHAN

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-46 is/are pending in the application.
4a) Of the above claim(s) 24 and 26-43 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 25 and 44-46 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 25 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/12/07 & 4/6/09
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 24 and 26-43, drawn to a surface top covering.

Group II, claim(s) 25 and 44-46, drawn to a method of converting a surface top into a promotional medium.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of providing a covering with a clear carrier film layer bearing a printed area forming a printed display layer constituting a promotional medium is known as shown for example by Buoniconti et al (U.S. 6,030,705). Buoniconti et al discloses a polycarbonate film for covering countertop. The covering includes providing a sheet or film of polycarbonate resin bearing on the lower surface a coating of pressure sensitive laminating adhesive, covered by a protective removable backing paper or release paper (Col 2, lines 1-6). Furthermore, the clear film can be printed with an infinite variety of colors or messages to be displayed (Col 3, lines 3-5) such as advertising (Col 3, lines 30-32). Therefore, the cited special technical features do not further the prior art and a lack of unity of invention exist between the covering and the method of converting a surface top.

3. During a telephone conversation with Gregory M. Reilly on April 2, 2009 a provisional election was made without traverse to prosecute the invention of group II, claims 25 and 44-46. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24 and 26-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result**

in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 44-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claim 44 recites the limitation "the table covering" in line 1. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 44 recites the limitation "said substrate" in line 2. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 44 recites the limitation "the table covering" in line 3. There is insufficient antecedent basis for this limitation in the claim.
11. Claim 45 recites the limitation "the edge or edges" in line 1. There is insufficient antecedent basis for this limitation in the claim.
12. Claim 45 recites the limitation "table covering" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.
13. Claim 45 recites the limitation "the table top" in line 2. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 45 recites the limitation "the edge" in line 2. There is insufficient antecedent basis for this limitation in the claim.
15. Claim 46 recites the limitation "the table covering" in line 1. There is insufficient antecedent basis for this limitation in the claim.
16. Claim 46 recites the limitation "table top" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 25, 45, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Buoniconti et al (U.S. 6,030,705).

Regarding claim 25, Buoniconti et al discloses a method of applying a polycarbonate film to countertops. The method includes thoroughly cleans the counter surface to remove any dirt, dust or other contaminates, providing polycarbonate sheet or film with a lower surface bearing a coating of pressure sensitive adhesive covered by a removable peel-way backing paper or release liner (Col 2, lines 1-24), wherein the film or sheet is a clear film and can be printed on the protected second surface with infinite variety of colors or message to be displayed (Col 3, lines 3-5), which can includes advertising (Col 3, lines 30-33) with a strong adhesive, which resist peel-up unless deliberate, strong forces is used and when a replacement is needed, the film is peel

away and any remaining adhesive can be removed using a wood chisel (Col 3, lines 24-29). The film is applied to countertop by peeling the release paper to expose the adhesive and pressing and adhering the film to one edge of the countertop (Col 2, lines 29-38).

Regarding claims 45 and 46, Buoniconti et al discloses the covering sheet or film is cut to allow about a 1" overlap over all side edges of the counter (Col 2, lines 25-28), which required the film or sheet to conform any shape or size of the counter.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

21. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buoniconti et al (U.S. 6,030,705) as applied to claim 25 above, and further in view of Kato et al (JP 2003-154795).

Buoniconti et al as disclosed above is silent as to the film or sheet includes a second release liner. However, providing a release liner for upper surface of the covering film is well known and conventional as shown for example by Kato et al. Kato et al discloses a transfer sheet for decorative material with a protective layer. Kato et al discloses the method includes providing a substrate sheet with a release layer and coating the protective film material such as acrylic resin to the surface of the substrate sheet (See Machine English Translation of JP 2003-154795, Paragraphs 10-15), which can provide a mirror finish to the protective layer and providing pattern layer onto the protective layer and glue (See Machine English Translation of JP 2003-154795, Paragraphs 18-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form protective sheet or film by coating the protective sheet or film material onto a release liner by as disclosed by Kato et al in the method of Buoniconti et al to provide a decorative film with excellent adhesion and is manufactured by simple process (See English Abstract of JP 2003-154795).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SING P. CHAN whose telephone number is (571)272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sing P Chan/
Acting Examiner of Art Unit 1791

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791